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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,840	07/10/2006	Jean-Louis H. Gueret	052725.1484-00000	4272
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER GULLEDGE, BRIAN M	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			05/12/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/541,840

**Applicant(s)**

GUERET, JEAN-LOUIS H.

**Examiner**

Brian Guldge

**Art Unit**

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-54 is/are pending in the application.
- 4a) Of the above claim(s) 48-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-854/IC)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/17/06; 2/19/08; 7/16/08; 11/19/08.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I (claims 18-47) in the reply filed on February 9, 2009 is acknowledged. The traversal is on the ground(s) that no serious search burden was demonstrated. This is not found persuasive because the application was a national stage entry submitted under 35 U.S.C. 371, and as such the requirement for restriction is a demonstration that the application lacks unity of invention. See MPEP 1893.03(d). Claims 48-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

This application claims benefit to provisional application No. 60/443,556, filed on January 30, 2003, in a language other than English. An English translation of the non-English language provisional application and a statement that the translation is accurate must be filed in provisional application No. 60/443,556. See 37 CFR 1.78(a)(5). The English translation of the non-English language provisional application and a statement that the translation is accurate required by 37 CFR 1.78(a)(5) is missing. Accordingly, applicant must supply 1) the missing English translation of the non-English language provisional application and a statement that the translation is accurate in provisional application No. 60/443,556 and 2) in the present application, a confirmation that the translation and statement were filed in the provisional

application. If 1) and 2) are not filed (or the benefit claim withdrawn by the filing of an amendment or Supplemental Application Data Sheet) prior to the expiration of the time period set in this Office action, the present application will be abandoned. See 37 CFR 1.78(a)(5)(iv).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 18-19, 21-25, 27, 34-36, 44-45, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Clay (US Patent 5,775,344).** Clay discloses a closed cosmetic container with a cap to which is mounted an applicator branch. There is a heat facilitating strip between the interior and exterior wall of the base cosmetic container. With the container closed, the heat facilitating strips are activated and a heatable cosmetic substance blends together dissolving any clogged or hardened cosmetic material (abstract and Figure 1). The container provides the user an efficient method of applying warmed toiletry products such as body lotion, shaving cream, or rubbing ointment to the body, with the heated substance providing aesthetic and soothing qualities during application (column 5, lines 51-56). The outside of the container does not have the composition, and stays dry during heating. The applicator can be a brush (figure 2). This device and its method of use disclosed by Clay anticipates the method of applying a cosmetic product recited in instant claims 18-19, 21-25, 27, 34-36, 44-45, and 47.

**Claims 18-23, 25-26, 29-30, and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Strack et al. (US Patent 4,913,957).** Strack et al. discloses a method to provide a fabric laminate which can be heated by means of microwave energy (column 2, lines 4-8). The skin contact layer consists of a thin soft absorbent layer for absorbing, holding, and delivering the treatment lotion, and is preferably made from thermoplastic fibers (column 2, lines 15-22). There is also a reservoir layer and opposite to the skin contact layer is a nonporous barrier layer (column 2, lines 10-15). Strack et al. further discloses when applying moisturizing lotions that heating the skin increases the flow of blood to the treated area and thereby provides a more rapid diffusion of the lotion (column 1, lines 11-21). The fabric laminate is heated to about 120 °F, which is 49 °C (column 5, lines 26-38). This object and its method of use disclosed by Strack et al. anticipates the method of applying a cosmetic product recited in instant claims 18-23, 25-26, 29-30, and 44-46.

**Claims 18-19, 24, and 37-43 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-077038-U.** The reference is in Japanese, so the English language machine translation (hereafter '038) will be referenced to provide the rationale for this rejection.

The '038 reference discloses a plastic container (which is dry on the outside) that comprises a depilation waxing compound, and the container is warmed to make the internal cosmetic a proper temperature, then extruding and using it outside of the tube (paragraph [2], lines 1-6). The tube has a display label attached that has printed on it a temperature-sensing and color-changing property ink, and when heated the ink changes color when the tube is heated such that the cosmetic composition reaches the proper temperature (paragraph [3], lines 1-10). This

object and its method of use disclosed by the '038 reference anticipates the method of applying a cosmetic product recited in instant claims 18-19, 24, and 37-43.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clay (US Patent 5,775,344) in view of Poucher's ("Poucher's Perfumes, Cosmetics, and Soaps", 10<sup>th</sup> Edition, 2000, pages 199-202).** Claim 28 recites that the liquid into which the carrier is submersed comprises water. While Clay discloses submerging the applicator (carrier) in the cosmetic (figure 1), Clay does not teach that the cosmetic comprises water. Clay does teach that the cosmetic substance can be mascara (column 1, lines 6-9).

Poucher's teaches that the most common types of mascaras are cream types that are oil-in-water emulsions (page 200, second full paragraph). Therefore, it would have been *prima facie* obvious at the time the invention was made to have used mascara that comprises water with the applicator taught by Clay. Poucher's discloses that most mascara have water.

**Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strack et al. (US Patent 4,913,957).** Strack et al. discloses using a microwave to heat the laminate object to 120 °F (column 5, lines 26-38). Strack et al. does not teach how long the laminate

needs to be heated to reach this temperature. However, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have determined how long the object would need to be heated in a microwave to reach 120 °F.

### *Conclusion*

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gullede whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612